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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,505	06/04/2001	Hongjie Cao	1928.PC	4692

7590 05/20/2003

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 05/20/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/873,505

Applicant(s)

CAO ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --.

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

Receipt is acknowledged of Amendment filed on March 24, 2003. Claims 26-48 are pending. Claim rejections under 35 U.S.C. § 112, second paragraph as indicated in the previous Office action dated October 22, 2002 is withdrawn in part in view of applicants' amendment and maintained in part for the reasons of record. Claim rejections under § 103 are maintained for the reasons of record.

#### ***Claim Rejections - 35 USC § 112***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 26-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "compound" renders claims 26, 32, 39, and 46 vague and indefinite. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). In chemical art, the term "compound" is known as a single species "composed of atoms or ions of two or more elements in chemical combination". See Condensed Chemical Dictionary. See p. 230.

Applicants define the term "compound" as "composed of or resulting from union of separate elements, ingredients, or parts", citing Webster's dictionary. Examiner notes that the definition from Condensed Chemical Dictionary is not a mere majority

view but it is how one having ordinary skill in chemical art defines the term "compound".

The usage of the term "compound" in the present case therefore renders instant claim

Remaining claims are rejected as depending on indefinite base claims.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 26-28, 39-42, and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskins et al. (US 5676994) ("Eskins") in view of Macaulay (US 6362146 B1).

Rejection is maintained for reasons of record.

2. Claims 29-31 and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskins and Macaulay as applied to claims 26-28, 39-42, and 46-48 above, and further in view of Ashley ("Sunburn and Sunscreen Preparations", Poucher's Perfumes, Cosmetics, and Soaps).

Rejection is maintained for reasons of record.

3. Claims 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskins in view of Van Soest (US 6340527 B1) and Fletcher et al. (U.S. Pat. No. 6,261,543 B1) ("Fletcher").

Rejection is maintained for reasons of record.

4. Claims 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskins and Van Soest as applied to claims 32-35 above, and further in view of Ashley.

Rejection is maintained for reasons of record.

***Response to Arguments***

Applicant's arguments filed on March 24, 2003 have been fully considered but they are not persuasive.

Applicants argue that the Eskin reference fails to teach that the composition reduces irritation caused by sunscreens agents. Applicants' argument is not commensurate with the scope of the claims. Examiner notes that instant claims are drawn to compositions, of which the limitations and components are found to be obvious over prior arts. The method claim, claim 46, is directed to method of making and topically applying the composition, which is also viewed obvious over the prior arts. The alleged irritation reducing property of the present invention is neither recited in the claims, nor is there evidence in the record to indicate that such property is unexpected or nonobvious. The present claims read on any aqueous compositions comprising the recited components, and the methods of making and using the same for topical application.

Similarly, applicants assert that the Ashley reference is not applicable since the composition therein requires surfactants which are not required in the instant inventions. Examiner notes that instant claims, reciting the transitional phrase "comprising" are open to include surfactants. See MPEP § 2111.03.

Applicants also argue that cationic starch as described in Van Soest is listed as laundry list of possible starches, lacking any recognition that cationic starch is a result-effective variable. Examiner respectfully disagrees, since the reference in fact states, "[s]uitable derivatives are oxidized starch (carboxy starch, dialdehyde starch),

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carboxyalkylated starch, sulphated or phosphated starch, cationic starch and the like".

Examiner takes the position that the presence of four or five different types of starch in the teaching does not negate the obviousness to select cationic starch which is said to be suitable encasing material for hydrophobic actives. Fletcher further provides motivation to choose cationic starch, which is said to provide stability in an aqueous emulsion. The rejections are viewed proper.

### ***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

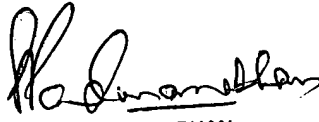
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone

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numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
May 6, 2003

  
SREENI PADMANABHAN  
PRIMARY EXAMINER

5/18/03